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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,965	07/30/2001	Herbert Martin Wilson	N1205-014	1608

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EXAMINER

HELMER, GEORGIA L

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,965

Applicant(s)

WILSON ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. The Office acknowledges receipt of Applicants Response; dated October 7, 2002, paper number 5.
2. Applicant has amended claims 22, 24, 27 and 28. Claims 22-28 are pending, and are examined in the instant action.
3. Applicant's Terminal Disclaimer, paper No 6, has been entered.
4. Applicant's substitute specification, paper No 7, is acknowledged, but it not entered. The substitute specification needs to be accompanied by a marked-up copy of the specification with all amendments to the specification indicated. The ~~sub~~ substitute specifications should not include any claims.
5. This action is made FINAL necessitated by Applicant's amendment.
6. All rejections not addressed below have been withdrawn.
7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112 second paragraph

8. Claims 22-28 remain rejected under 35 U.S.C. 112, second paragraph for reasons of record.

Claim 22 should be a method for producing a transformed corn plant, because transformed plants are what is produced by the method. As it stands, Claim 22 is to a method of transforming a cell of corn.

- Line, 3 "an immature embryo from said cell" implies that an embryo is a cell component.
- Line 4, "tissue of said cell" implies that tissues makes up a cell.

In claim 22 (c): "a resulting" should be changed to "the resulting" for proper antecedence.

- How is the purpose of step (c) different from step (d)?
- Claim 22 (e) "having growing Type II:" growing Type II what? The marked-up copy of the claim is different from the clean copy.
- Applicant should note that the marked-up copy should be the same as the clean copy.
- Claim 22 (f), "said embryo structures: lacks antecedent basis.

In claim 24, for clarification, "stock" should be inserted after the second "Agrobacterium" recitation.

In claim 28, "said" should be inserted before "antibiotic" for proper antecedence.

Claim Rejections - 35 USC § 112

9. Claims 22-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. In claim 22 (a):
Applicant has amended "gene" to recite "genetic element". The recited "genetic element" is new matter, not supported by the specification as originally filed.

Claim Rejections - 35 USC § 103

10. Claims 22-25 and 28 remain rejected for reasons of record.

Claims 22 and 23 remain rejected over Hansen, G. (US # 6,162,965) in view of Bhojwani, SS et al (Developments in Crop Science, vol 5, pp 24-41, 198).

Claims 22, 23, and 24 remain rejected over Hansen and Bhojwani, SS et al (as applied to claims 22, and 23, above, and further in view of Holton (US 5,948,955).

Claims 22, 23, and 25 are rejected over Hansen, G. (US # 6,162,965), Bhojwani, SS et al applied to claims 22 and 23 above, and Applicant's admitted prior art.

Claims 22, 23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen, G. (US # 6,162,965) Bhojwani, applied to claims 22 and 23 above, and further in view of Stomp (US 6,040,498).

- Applicant traverses, stating primarily that the cited references, when viewed separately or in combination, do not teach or suggest the claimed invention. Applicant's traversal has been considered and is unpersuasive because the combination of references properly render the claimed invention *prima facie* obvious, for reasons of record.

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- Applicant traverses, stating primarily that the Examiner has used an impermissible "obvious to try" standard in reaching the conclusion that Applicant's invention is obvious.
Applicant's traversal has been considered and is unpersuasive because Applicant has provided no evidence that the Office used an "obvious to try" standard.
- Applicant traverses, stating primarily that none of the references cited by the Examiner discloses or suggests using 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide. And that therefore, there is not a prima facie case of obviousness.
Applicant's traversal has been considered and is unpersuasive because Applicant's argument is not commensurate in scope with the claims. None of the claims recite the combination of 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide.
Therefore the rejection is maintained.
- Applicant traverses, stating primarily that Examiner has randomly picked bits or prior art references using the hindsight reasoning provided by Applicant's disclosure.

Applicant's traversal has been considered and is unpersuasive because

Applicant has provided no evidence as to why Applicant believes the Office has used hindsight reasoning.

- Applicant traverses, stating primarily that the Examiner's imputed conclusion of obviousness could only have been reached with the benefit of the hindsight application of the teachings of the present specification.

Applicant's traversal has been considered and is unpersuasive because

Applicant has provided no evidence that the Office has used hindsight, as discussed above.

Accordingly, these rejections are maintained.

REMARKS

11. No claims are allowed.
12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

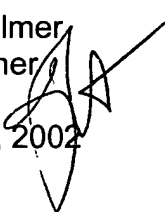
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer
Patent Examiner
Art Unit 1638
December 19, 2002



Phuong Bui
12/26/02